

REMARKS

Claims 1, 3-16 and 18-21 are pending in this application. By this Amendment, the Abstract is replaced with a substitute Abstract, the specification and claims 1 and 3-16 are amended, claims 2 and 17 are canceled, and claim 21 is added. Support for the amendments may be found, for example, in the original claims. No new matter is added.

In view of the foregoing amendments and the following remarks, reconsideration and allowance are respectfully requested.

I. Objections

The Office Action objects to the abstract and the specification for informalities. As indicated above, attached is a substitute abstract, and the specification is amended, to overcome the objections. Accordingly, reconsideration and withdrawal of the objections are respectfully requested.

II. Rejection Under 35 U.S.C. §112

The Office Action rejects claim 17 under 35 U.S.C. §112, second paragraph, as being indefinite. By this Amendment, claim 17 is canceled, rendering the rejection moot. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

III. Rejection Under 35 U.S.C. §101

The Office Action rejects claim 17 under 35 U.S.C. §101 because it is not presented in the format of a proper process claim. By this Amendment, claim 17 is canceled, rendering the rejection moot. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

IV. Rejection Under 35 U.S.C. §102

The Office Action rejects claims 1-20 under 35 U.S.C. §102(b) over U.S. Patent No. 5,688,905 to Walker ("Walker"). By this Amendment, claims 2 and 17 are canceled,

rendering their rejection moot. As to the remaining claims, Applicants respectfully traverse the rejection.

A. Claim 1

By this Amendment, claim 1 is directed to a Mannich base prepared by using at least one phenolic compound of formula (I). The claimed Mannich base has a low viscosity, such as less than 1000 mPas (see claim 8), or from about 200 to 700 mPas (see claim 21). Walker does not disclose selecting the phenolic compound of formula (I).

In order for the Mannich base to have low viscosity, as described above, it must be prepared from alkylphenol compounds that are unsubstituted at positions o and p with respect to the phenol group, such as "m-Xylenol" or "m-cresol." See specification at page 5, lines 9-14. Walker generally discloses Mannich bases that are "condensates of phenol or an alkyl phenol" but is completely silent on using bases that are unsubstituted at the o and p positions. Applicants respectfully submit that phenols and alkyl phenols that are substituted at positions o and p with respect to the phenol group do not yield Mannich bases having low viscosity. Thus, an ordinarily skilled artisan would not have selected the phenolic compound of claim 1.

Moreover, Walker does not disclose "m-Xylenol" because m-Xylenol is a dialkylphenol. As described above, Walker merely discloses Mannich bases that are condensates of "phenol or an alkyl phenol," and does not disclose m-Xylenol, which is a dialkylphenol (see claim 6).

B. Claim 9

Claim 9 is directed to a method of producing a Mannich base and requires a two-stage process for producing a Mannich base where "the phenolic compound is reacted with the formaldehyde in the presence of a tertiary amine, and a resulting product is reacted with the at least one polyamine." The two-stage process of claim 1 provides a Mannich base with low viscosity. Walker does not disclose the claimed method for the following reasons.

Walker discloses an "amine hardener composition for curing epoxy resin based coatings" comprising a diamine, a Mannich base, and a polyamine. See Abstract. Walker does not disclose, however, a two-stage process by which the Mannich base is made. Instead, Walker merely discloses that Mannich bases are "condensates of phenol or an alkyl phenol, formaldehyde, and a di- or polyamine" and that a Mannich base is a component of an amine hardener composition. See column 3, lines 31-53.

C. Conclusion

For at least the foregoing reasons, Walker does not anticipate claims 1 and 9. Claims 3-16 and 18-20 depend from claims 1 and 9 and, thus, also are not anticipated by Walker for at least the same reasons. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

V. Obviousness-Type Double Patenting Rejection

The Office Action provisionally rejects claims 1-6 and 9-16 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 of co-pending Application No. 10/552,481. Applicants respectfully traverse the rejection. Without admitting to the propriety of the rejection, and in the interest of advancing prosecution, Applicants are simultaneously filing herewith a Terminal Disclaimer over the co-pending application, thus obviating the rejection. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

VI. New Claim

By this Amendment, new claim 21 is presented. New claim 21 depends from claim 1 and, thus, distinguish over the applied reference for at least the reasons discussed above with respect to claim 1. Prompt examination and allowance of new claim 21 are respectfully requested.

VII. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of the claims are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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Attachments:

Substitute Abstract
Terminal Disclaimer

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